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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,076	01/16/2002	Dan Kikinis	P1553D2	3459

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EXAMINER

WINDER, PATRICE L

ART UNIT PAPER NUMBER

2145

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/052,076

Applicant(s)

KIKINIS, DAN

Examiner

Patrice Winder

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16,18,19 and 21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 16,18,19 and 21 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 16 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not provide enablement for a code sent from the user computer to instruct a server to transmit emails directly to the portable device. The specification supports "a code is sent to the host server 120 indicating now the subscriber is in the field" on page 7, lines 28-29.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "code sent from the user computer to transmit the emails directly to the portable device" and/or "a code sent from the user computer to transmits the emails directly to the portable device by a wireless transmission facility".

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16, 18-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wicks et al., USPN 5,796,394 (hereafter referred to as Wicks) in view of Boyer et al., USPN 6,401,112 B1 (hereafter referred to as Boyer) further in view of McHann, Jr., 5,991,806 (hereafter referred to as McHann).

6. Regarding claim 16, Wicks taught a system for delivering emails to a user (abstract), comprising:

a network-connected server for receiving and processing the emails (column 4, lines 1-7);

a database at the network server for storing user preferences used by the network-connected server for processing the emails (column 5, lines 37-52; column 11, lines 48-58);

a wireless transmission facility in communication with the network-connected server, for transmitting the emails (column 6, lines 42-46); and

a portable playback device enabled for connection to a user computer (column 5, lines 20-31), receiving emails transmitted by a transmission facility and the wireless transmission facility transmits the emails directly to the portable device (column 11, line

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59 – column 12, line 14). Wicks does not specifically detail the interaction between the portable playback device and the user computer. However, Boyer taught a portable device displaying the emails as text to the user (column 3, lines 51-57) and wherein a server transmits emails to the user computer for download to the portable device via the network while the device is connected to the user computer (column 5, lines 43-54). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Boyer's synchronized portable computer in Wick's personal communications routing system would have would expanded system utility. The motivation would have been to incorporate docketing connections for other types of personal digital assistants.

Wicks does not specifically teach upon disconnection of the portable device from the user computer a server is instructed by code sent from the user computer. However, McHann taught upon disconnection of the portable device from the user computer a server is instructed by code sent from the user computer (column 14, lines 54-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating McHann's undocking code in Wick's personal communications routing system would have improved system robustness. The motivation would have been to provide more efficient management of system resources by releasing system resources when the portable device becomes undocked.

7. Regarding dependent claim 18, Wicks taught wherein the network is Internet network (column 4, lines 1-5).

8. Regarding claim 19, Wicks taught a method for delivering multimedia emails to a user, comprising the steps of:

a) receiving the multimedia emails on a network by a network-connected server (column 4, lines 1-8);

b) storing user preferences at a database at the network-connected server (column 5, lines 37-52, column 11, lines 48-58);

c) processing the emails at the network-connected server by accessing the user preferences (column 11, lines 48-58);

d) transmitting individual ones of the emails over the network by the network-connected server (column 6, lines 5-10);

f) editing the user preferences via direct communication from the playback device (column 9, lines 11-26); and

transmitting emails directly to the portable device by a wireless transmission facility (column 11, line 59 – column 12, line 14).

Wicks does not specifically teach the interaction between the user computer and the portable playback device. However, Boyer taught e) receiving the transmitted emails at a user computer for download to a portable playback device connected to the user computer and displaying the emails on a display of the playback device (column 3, lines 51-57); and

wherein the network-connected server transmits emails to the user computer for download to the portable device via the network while the device is connected to the user computer (column 5, lines 43-54). It would have been obvious to one of ordinary

skill in the art at the time the invention was made that incorporating Boyer's synchronized portable computer in Wick's personal communications routing system would have would expanded system utility. The motivation would have been to incorporate docketing connections for other types of personal digital assistants.

Wicks does not specifically upon disconnection of the portable device from the user computer the network-connected server is instructed by code sent from the user computer. However, McHann taught upon disconnection of the portable device from the user computer a server is instructed by code sent from the user computer (column 14, lines 54-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating McHann's undocking code in Wick's personal communications routing system would have improved system robustness. The motivation would have been to provide more efficient management of system resources by releasing system resources when the portable device becomes undocked.

9. Regarding dependent claim 21, Wicks taught wherein the network is the Internet (column 4, lines 1-5).

Response to Arguments

10. Applicant's arguments filed June 21, 2006 have been fully considered but they are not persuasive.

11. Applicant argues – "Clearly the above teaching from applicant's specification teaches that the user's computer sends code to a server upon disconnect of the

portable device to redirect information updates, which includes incoming email as disclosed on page 10, lines 1-12 of application's specification."

a. Applicant appears to miss the Examiner's point in raising the issue.

Applicant admits in this argument "the code" is sent to indicate that the user in the field, i.e. at a different location. Thus, the function of "the code" is to update the user's location, not to command the update server to send emails. Applicant's specification lacks description of the "update server" responding to "the code" by forwarding emails to user's location.

12. Applicant argues – "Boyer fails to teach that the portable device receives email via a wireless device remote from the user's computer and displays the text to the user." "Applicant argues that McHann fails to teach upon disconnection of the portable from the user computer the wireless transmission facility is instructed by code sent from the user computer to transmit the emails directly to the portable device."

b. Neither assertion addresses the rejection made by the Examiner. The combination of Wicks-Boys-McHann in combination taught "the portable device receives email via a wireless device remote from the user's computer and displays the text to the user".

c. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

13. Applicant argues – Wicks, Boys and McHann are non-analogous art.

d. In response to applicant's argument that Boyer and McHann are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Boyer describes the "synchronizing" of a portable device with a personal computer. McHann teaches "signaling" that a portable device has been "disconnected". Wicks taught a wireless transmission facility transmitting emails. The operations of "synchronizing" and "disconnecting" are suggested in Wicks but are not "explicitly" detailed.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 571-272-3935. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Patrice Winder
Primary Examiner
Art Unit 2145

August 31, 2006